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EXAMINER

GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,354

Applicant(s)

WEBER ET AL.

Examiner

Yogesh C Garg

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Mh

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/24/03.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-19 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-19, 21-33 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Amendment A, paper # 8, received on November 24, 2003, is acknowledged and entered. Claims 4, 20 and 34 have been cancelled. Claims 1, 9, 11, 26, 32, 33 and 44 have been amended. Currently claims 1-3, 5-19, 21-33 and 35-55 are pending for examination.

Response to Arguments

2. The applicant's arguments (see page 13 of the amendment A) regarding rejection of claims 1-10, 12 and 22-32 under 35 U.S.C. 112, 2nd paragraph have been fully considered and found persuasive. The applicant argues that the steps for creating or generating a set of individualized enhancements and design selections are not required as they are not claimed as exemplified with a system for measuring a signal where the applicant would not be required to claim the generation of the signal for measuring it. Accordingly, this rejection is withdrawn.

The applicant has amended claims 26, 32 and 44 and, therefore, the rejection of claims 1-10, 12 and 22-32 under 35 U.S.C. 112, 2nd paragraph of the previous Office action is withdrawn.

The applicant argues that the teachings of Lahey reference cannot be combined with the reference Rosen because Lahey's art is not in the same field of endeavor or discloses analogous art addressing the same problems as addressed in the applicant's claims 4, 34, 11, 22, 27, 37 and 46 (see pages 14-16). The examiner respectfully disagrees because Lahey's teachings, as applied to the claims 4, 34, 11, 22, 27, 37 and

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46 is an analogous art and reasonably pertinent to the particular problem with which the applicant was concerned (Please refer to MPEP 2141.01 (a)..... *"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned."* *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). PTO CLASSIFICATION IS SOME EVIDENCE OF ANALOGY, BUT SIMILARITIES AND DIFFERENCES IN STRUCTURE AND FUNCTION CARRY MORE WEIGHT..... While Patent Office classification of references and the cross-references in the official search notes are some evidence of "nonanalogy" or "analogy" respectively, the court has found "the similarities and differences in structure and function of the inventions to carry far greater weight." *In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (The structural similarities and functional overlap between the structural gratings shown by one reference and the shoe scrapers of the type shown by another reference were readily apparent, and therefore the arts to which the reference patents belonged were reasonably pertinent to the art with which appellant's invention dealt (pedestrian floor gratings).); *In re Clay*, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992)

With regards to the claims 4 and 34, the limitations of which are now added to the newly amended claims 1 and 33 recite presenting to the user a default set of product configurations and a default set of enhancements. This data is presented by a host merchant computer (see page 13 of the amendment). The hardware used is a host computer/server using a software,

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which manipulates the stored information in a memory in the digitized format, to present the default set of information to the user. The enhancements and the product configurations are not the claimed subject matter. The claimed invention comprises the manipulative steps of receiving, selecting or displaying (as admitted by the applicant on page 13 on the amendment). The Lahey reference also uses a computer and a software program to present the default set of information, which manipulates the stored information in a memory in the digitized format, to present the default set of information to the user. The difference in the Lahey's and the applicant's teachings is that Lahey's teachings relate to print jobs and the applicant's teachings relate to products but in both the cases the same system of hardware/software, that is computers and software programs are used to solve the same problem of presenting a default set of parameters. It would be obvious that one of ordinary skill in the computerized software programs art faced with the problem of presenting default set of information using a computer to look to the solutions of other faced with the problem of presenting default set of information, and therefore the reference of Lahey and the applicant's teachings are in analogous art. Please refer to the example " Analogy in the Electrical Arts of MPEP 2141.01 (a) as reproduced below:

ANALOGY IN THE ELECTRICAL ARTS

See, for example, Wang Laboratories, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Patent claims were directed to single in-line memory modules (SIMMs) for installation on a printed circuit motherboard for use in personal computers. Reference to a SIMM for an industrial controller was not necessarily in the same field of endeavor as the claimed subject matter merely because it related to memories. Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories. Furthermore, since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories, the finding that the reference was nonanalogous was supported by substantial evidence.); Medtronic, Inc. v. Cardiac Pacemakers, 721 F.2d 1563, 220 USPQ 97 (Fed. Cir. 1983) (Patent claims were drawn to a cardiac pacemaker which comprised, among other components, a runaway inhibitor means for preventing a pacemaker malfunction from causing pulses to be applied at too high a frequency rate. Two references disclosed circuits used in high power, high frequency devices which inhibited the runaway of pulses from a pulse source. The court held that one of ordinary skill in the pacemaker designer art faced with a rate-limiting

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problem would look to the solutions of others faced with rate limiting problems, and therefore the references were in an analogous art.)

Using the same rationale as discussed for claims 4 and 34 above, the teachings of Lahey reference with regards to claims 11, 22, 27, 37 and 46 constitute analogous art to the applicant's teachings. As discussed and analyzed above the teachings of the reference Lahey are analogous in solving the same problems as addressed by the applicant it is proper to combine Lahey's teachings with Rosen for the obvious reasons/motivation as already presented in the previous Office action under the heading "Claim rejections-35 USC 103".

In view of the foregoing, the rejection of all the currently pending claims is maintained as unpatentable over Rosen in view of Lahey.

This is a Final Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Amended claim 1 contains newly added subject matter "with different manufacturing capabilities associated with each product..." which implies that the selected product themselves have the capabilities to be manufactured differently and examiner could not

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find support for this limitation in the disclosure. Since claims 2-10 are dependencies of claim 1 they are also rejected.

3.1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Amended claim 1 contains newly added subject matter " with different manufacturing capabilities associated with each product..." from which it is unclear if the product themselves have the capabilities to be manufactured differently or the system/design provides the capability to manufacture them differently that is they can be personalized/individualized/customized. The disclosure does not support the first interpretation. As best understood by the examiner, the second interpretation that is the selected products can be individualized/personalized/customized is supported by the disclosure and will be further treated on merits. The applicant is requested to amend the claim to provide a clear and unambiguous meaning as best understood by the examiner and supported by the disclosure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4.1. Claims 1-3, 5-6, 9, 11-13, 15-17, 22-24, 26-30, 32, 35-41, 45-51 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen and further in view of Lahey.

Regarding claim 1, Rosen teaches a method for facilitating the creation of personalized products, for use in a system where a user on a user computer can access at least one host merchant computer via a communication network, the host merchant computer including a web server in communication with a products database containing information on products available for personalization and further containing manufacturing capabilities for the products (see at least abstract, Fig.2, Fig.3), the method comprising:

providing to the user via said communication network at least one web page providing an assortment of product selections with different manufacturing capabilities associated with each product (see at least FIG.9B which shows a web page providing an assortment of product selections, such as, different types of flavors, col.5, lines 19-27, col.10, lines 7-18, "....The order specification WWW page 190 includes a WWW form for selecting the quantity and type of customized branded merchandise to be ordered.....may select the type [e.g. orange, strawberry. Note: As analyzed above "product selections with different manufacturing capabilities associated with each product" corresponds to personalize/customize the products and which Rosen already teaches as discussed above]) " available in said products database (see FIG.3, "Product Database 98");

receiving a message from the user via said communication network indicating a selection of a product from said assortment (see at least col.10, lines 7-18, "....The order specification WWW page 190 includes a WWW form for selecting the quantity and type of

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customized branded merchandize to be ordered... According to an actual embodiment of the present invention, the consumer may select the type [e.g. orange, strawberry].....");

retrieving a set of manufacturing capabilities for said selected product from the products database (see at least FIGs. 8A & 9A, "The measurements shown are the minimum requirements for your artwork to get a quality label", FIG.8B, "...You have about 50 characters space", and "You have as much room as the text shows below. Anything longer will get chopped off after 65 words", col.9, lines 49-55, ".. the consumer may be required to provide a graphic image not exceeding a predetermined size". Note: The display of size restrictions for the image and the space restrictions for the amount of text to be input correspond to retrieving and showing the manufacturing capabilities which restrict the products to be personalized);

providing to the user via said communication network a design interface, said design interface comprising at least one web page including at least one design tool that allows the user to select predetermined design selections and to create individualized enhancements, and wherein said design tool is conformed to only allow configuration options and enhancements which satisfy said manufacturing capabilities;

creating at least one set of individualized enhancement for said selected product;

(see at least FIG.9C and col.10, lines 10-47, "...Referring now to FIG. 9C...a JAVA applet for image manipulation may be transmitted from WWW server 34 to client computer 32 for execution within WWW browser 118.....an applet for cropping the graphic image 194 is provided....to crop the image to a suitable size....A selection tool 196 is also provided to allow the consumer to select a portion of the graphic image 194.....". Note: The WWW page 190 allows the user to select product flavors which correspond to a tool selecting product configuration options and the JAVA applet for image manipulation corresponds to the design tool to select graphic image, manipulate/configure the images as per his personal choices); and

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receiving from the user via said design interface a set of design configuration selections and a set of individualized enhancements for said selected product (see at least col.10, lines 43-47, " Once the consumer has completed the manipulation.....selected the quantity and type of customized branded merchandise to be ordered , the WWW server 34 may provide a checkout page 200.....").

Rosen does not teach that said design interface presents to the user a default set of product configuration options and a default set of enhancements.

Lahey, in the same field of endeavor, i.e. customization of print jobs, teaches that design interface presents to the user a default set of product configuration options and a default set of enhancements (see at least col.15, lines 47-53, "...The user may customize the search dialog boxes 190,202 with the default option....."col.11, lines 61-65).

In view of Lahey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen to include the feature such that design interface presents to the user a default set of product configuration options and a default set of enhancements. Doing so would enable the users/buyers to display the default features of the personalized design components/enhancements when he accesses the host merchant site again to order additional quantity and would not have to go through the process of custom designing and enhancing the product from the very beginning. Then the user can repeat the same product or modify specific features only which he wants new in the second product.

Regarding claim 2, Rosen discloses that said individualized enhancements include a pictorial image incorporated onto said selected product with an image position determined by the user (see at least col.10, lines 19-42, ".....image manipulation....").

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Regarding claim 3, Rosen teaches including a text message incorporated onto said selected product with a text position determined by the user (col.5, lines 19-27, " ... to customize the merchandize by providing a graphic image and a text message " and lines 39-43, " having labels customized with a graphic image and a text message provided by consumer 30 ". Note: Allowing consumer the merchandize with text message would inherently allow customer to position the text as per his choice).

Regarding claim 5, Rosen teaches receiving a search query from the user via said communication network; and

presenting to the user via said communication network an assortment of digital image selections retrieved from at least one digital image database in communication with said design interface, wherein said assortment satisfies said search query.

(see at least col.11, lines 34-42, wherein Rosen teaches that the user selects an item from menu to display [corresponds to receiving a search query] and in response a gallery of graphic images is displayed [corresponds to presenting the user with digital image selections as per search query] retrieved from image database 100-see FIG.3).

Regarding claim 6, Rosen teaches receiving from said user via said communication network a selected image from said assortment of digital image selections; and

incorporating said selected image into said set of individualized enhancements using said design tool.

(see at least col.11, lines 34-42 and col.12, lines col.12, lines 5-13, "...At step 1310 a graphic image is received. As described above [see at least col.10, lines 19-42], the graphic image may have been cropped.....a text message is received ").

Regarding claim 9, Rosen teaches a method for facilitating the creation of personalized products as analyzed and disclosed in claim 1, above.

Rosen does not teach receiving from the user via said communication network a request to save said set of product configurations and said set of individualized enhancements; and storing said set of product configuration selections and said set of individualized enhancements in a location accessible to that user via said communication network.

Lahey, in the same field of endeavor, i.e. customization of print jobs, teaches receiving from the user via said communication network a request to save said set of product configurations and said set of individualized enhancements; and storing said set of product configuration selections and said set of individualized enhancements in a location accessible to that user via said communication network (see at least col.15, lines 47-53. The selection of "Set Default button" for customized search dialog boxes corresponds to receiving a request to save said set of product configurations and said set of individualized enhancements and storing them such that it is s accessible when dialog boxes 190,202 are invoked later.).

In view of Lahey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen to include the feature of receiving from the user via said communication network a request to save said set of product configurations and said set of individualized enhancements; and storing said set of product configuration selections and said set of individualized enhancements in a location accessible to that user via said communication network. Doing so would make the system efficient and convenient by enabling the users/buyers to display the saved default features of the personalized design components/enhancements to order additional quantity with the same features or to modify

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some parameters in the default features without having to go through the process of custom designing and enhancing the product from the very beginning.

Regarding method claims 11-13, all limitations have been analyzed in claims 1 -2 and 9 above.

Regarding claim 15, its limitations are analyzed as in claim 1 above.

Regarding method claims 16-17, all limitations have been analyzed per claims 5 and 6 above.

Regarding claim 22, Rosen teaches a method for facilitating the creation of personalized products (see at least abstract, Fig.1, Fig.2), comprising:

receiving from a user via a communication network a first set of design components created for a first product, said first set of design components corresponding to product configuration options and individualized enhancements(see at least col.10, lines 42-47. Note: This process is repeated for every product irrespective of the fact whether it is first or second product);

receiving from the user via said communication network an identifier for a second product selected for personalization (see at least col.10, lines 7-18, ""....The order specification WWW page 190 includes a WWW form for selecting the quantity ant type of customized branded merchandize to be ordered... According to an actual embodiment of the present invention, the consumer may select the type [e.g. orange, strawberry].....". Note: This process is repeated for every product irrespective of the fact whether it is first or second product);

retrieving a set of manufacturing capabilities for said second product (This limitation is already analyzed in claim 1 above. This process is repeated for every product irrespective of the fact whether it is first or second product);

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providing to the user a design interface comprising at least one design tool enabling the user to create said design components, wherein said design interface is adapted so that the user may only create design components which comply with said set of manufacturing capabilities and this is applicable irrespective of the fact if it is first or second set of design components;

creating at least one set of individualized enhancements for said selected product using said design interface; and

receiving from the user via said design interface a set of product configuration options and a set of individualized enhancements for said selected product.

(All the above limitations are parallel to the limitations in claim 1 above and are analyzed on the basis of same rationale.).

Rosen does not show modifying said first set of design components and generating a second set of design components derived from said first set of design components.

Lahey, in the same field of endeavor, i.e. customization of print jobs, teaches modifying said first set of design components and generating a second set of design components derived from said first set of design components (see at least col.15, lines 47-62, "...The user may customize the search dialog boxes 190,202 with the default option.....the user saves the present search operators.....When the search dialog is later invoked, those default search operators and values appear.....The user may further customize and modify....when the user selects the Customize button.....". Note: The user saves the parameters/operators for the first product, retrieves them later by pressing default button and then modifies and customizes the operators/parameters by pressing the customize button for a new product which could be second or third product.).

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In view of Lahey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen to include the feature of modifying said first set of design components and generating a second set of design components derived from said first set of design components because this would enable the users/buyers to display the default design features set for the first product and would not have to go through the process of custom designing and enhancing the subsequent/second or third product from the very beginning but merely modify some of the features required to customize a subsequent product, as explicitly disclosed in Lahey.

Regarding claims 23, 24, and 26, their limitations are already analyzed in claims 1, 5, and 9 above.

Regarding claim 27, Rosen teaches a method for facilitating the creation of personalized products, for use in a system where a user on a user computer can access at least one host merchant computer via a communication network (see at least abstract, Fig.1, Fig:2), the method comprising:

providing to the user via said communication network a design interface, said design interface comprising at least one design tool that allows the user to select product configuration options and to create individualized enhancements,
said configuration options and individualized enhancements comprising design components :

creating at least one set of individualized enhancements for said selected product using said design interface;

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receiving a first set of design components corresponding to a first set of individualized enhancements from the user via said design interface before a product to be personalized has been identified;

receiving an identifier for a product selected for personalization from the user via said communication network;

retrieving a set of manufacturing capabilities for said selected product;

adapting said design interface so that the user may only select product configuration options and create individualized enhancements satisfying said set of manufacturing capabilities.

(All the above limitations are parallel to the limitations in claim 1 above and are analyzed on the basis of same rationale.).

Rosen does not show generating a second set of design components derived from said first set of design components and loading said second set of design components into said design interface.

Lahey, in the same field of endeavor, i.e. customization of print jobs, teaches generating a second set of design components derived from said first set of design components and loading said second set of design components into said design interface (see at least col.15, lines 47-62, "...The user may customize the search dialog boxes 190,202 with the default option.....the user saves the present search operators.....When the search dialog is later invoked, those default search operators and values appear.....The user may further customize and modify....when the user selects the Customize button.....". Note: The user saves the parameters/operators for the first product, retrieves them later by pressing default button and then modifies and customizes the operators/parameters by pressing the customize button for a new product which could be second or third product.).

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In view of Lahey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen to include the feature of generating a second set of design components derived from said first set of design components and loading said second set of design components into said design interface because this would enable the users/buyers to display the default design features set for the first product and would not have to go through the process of custom designing and enhancing the subsequent/second or third product from the very beginning but merely modify some of the features required to customize a subsequent product, as explicitly disclosed in Lahey.

Regarding claims 28, 29, 30, and 32, their limitations are already analyzed in claims 23, 1, 24, and 26 above respectively.

Regarding method claim 33, all limitations are parallel to the limitations of claim 1 and are therefore analyzed on the basis of same rationale.

Regarding method claims 35-36, all limitations are parallel to the limitations of claims 2-3 and are therefore analyzed on the basis of same rationale.

Regarding claim 37, Rosen discloses a system to allow a user to design personalized products, the system accessible to a user on a user computer via a communication network (see at least abstract, Fig. 1, 2, 3, 4, and 5), the system comprising:

a server in communication with said communication network (see at least FIGs. 2 & 3, "WWW Server 34" in communication with a communication network, "Internet 20");

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a products database in communication with said server, said products database comprising information on an assortment of product selections available for personalization, and further comprising manufacturing capabilities for said product selections (see FIG. 3, "Product database 98", "Image Database 100", FIG.4, "Image Processing Applet" are in communication with WWW server 34 and include information on product selections and manufacturing capabilities. Also see Figs. 8A & 9A, "The measurements shown are the minimum requirements for your artwork to get a quality label", FIG.8B, "...You have about 50 characters space", and "You have as much room as the text shows below. Anything longer will get chopped off after 65 words", col.9, lines 49-55, "...In an embodiment of the present invention, the consumer may be required to provide a graphic image not exceeding a predetermined size". Note: The display of size restrictions for the image and the space restrictions for the amount of text to be input correspond to retrieving and showing the manufacturing capabilities which restrict the products to be personalized) ;

a personalized product module in communication with said products database, said personalized product module capable of presenting an assortment of product selections to the user, and said personalized product module further capable of receiving an identifier of a selected product from the user (see at least col.5, line 64-col.6, line 67, ".....The WWW server 34 also includes a processing unit 62.....operating system....mass memory 66 also stores the program code and data for providing a WWW site for creating and ordering customized branded merchandize....WWW server application program 72 comprisesgenerate the WWW browser displays shown in FIGS 6-11B....". See col.5, lines 19-27, " ...allow consumer 30 to identify the merchandize they wish to order, to customize the merchandize by providing a graphic image and a text message " , and FIG.9B and Col.10, lines 7-18 which show a web

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page providing an assortment of product selections, such as, different types of flavors., e.g. orange, strawberry).

a set of design tools in communication with said personalized product module that allow the user to select product configuration options and create individualized enhancements, wherein said set of design tools is adaptable to only accept product configuration selections and individualized enhancements which comply with a set of manufacturing capabilities associated with said selected product (see at least col.10, lines 10-42. Note: The WWW page 190 allows selecting product flavors which correspond to a tool selecting product configuration options and the JAVA applet for image manipulation corresponds to the design tool).

Rosen does not disclose a design buffer in communication with said set of design tools, said design buffer capable of containing product configuration options and individualized enhancements generated by the user via said set of design tools during a current design session.

Lahey, in the same field of endeavor, i.e. customization of print jobs, disclose a design buffer in communication with said set of design tools, said design buffer capable of containing product configuration options and individualized enhancements generated by the user via said set of design tools during a current design session.

(see at least col.15, lines 47-53. The selection of "Set Default button" to save and store the customized search dialog boxes and invoking the dialog boxes 190, 202 to view the default search operators and values correspond to the design buffer in the application).

In view of Lahey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen to include the feature of design buffer in communication with said set of design tools, said design buffer capable of containing product configuration options and individualized enhancements generated by the user via said set of

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design tools during a current design session. Doing so would make the system efficient and convenient by enabling the users/buyers to display the saved default features of the personalized design components/enhancements to order additional quantity with the same features or to modify some parameters in the default features for ordering subsequent products without having to go through the process of custom designing and enhancing the product from the very beginning.

Regarding claims 38-41, Rosen/Lahey discloses:

a product browse tool in communication with said products database, wherein said product browse tool enables a user to browse said assortment of product selections of said products database .

a product search tool in communication with said products database, wherein said product search tool enables a user to search said assortment of product selections of said products database for products associated with a search query.

an image browse tool in communication with said image databases, wherein said image browse tool enables a user to browse said assortment of digital image selections of said image databases.

an image search tool in communication with said image databases, wherein said image search tool enables a user to search said assortment of digital image selections of said image databases for images associated with a search query.

(col.4, line 62-col.5, line 63, "...once connected to the Internet 20, a client computer 32 may utilize a WWW browser application program to view and interact with WWW site....to customize the merchandise by providing a graphic image.....". Note: The browser application program is capable to browse and select products and images).

Regarding claim 45, Rosen/Lahey teaches all the limitations of claim 37 as analyzed above. Rosen/Lahey as applied to claim 37 further teaches:

a template database in communication with said set of design tools, said template database comprising default sets of design components for each product of said product database; and

a template module in communication with said template database that generates a default set of design components for a particular product selected by the user for presentation to the user at the beginning of the design process

(see at least Lahey, col.15, lines 47-62. BY selecting the "Set Default button" the parameters are saved and stored as "Default parameters" to be invoked later to display them to the user or to be used to modify and generate a new default parameters. The storage of default parameters corresponds to a template database and selecting "set Default button" to generate default parameters correspond to a template module.).

Regarding claims 46-48, 50-51, and 54-55, their limitations are covered by the limitations of claims 37-41, and 44-45 and are therefore analyzed and rejected as unpatentable over Rosen/Lahey.

Regarding claim 49, Rosen/Lahey teaches all the limitations of claim 46 as analyzed above. Rosen/Lahey also discloses:

at least one image database in communication with said second module, said image databases comprising an assortment of digital image selections (see at least FIG.3, "...Image Database 100", col.6, lines 59-61, col.11, lines 10-11, " Viewing a gallery of images supplied by

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other users ". Note: The image database is in communication with the WWW page 190 and image manipulation applet r(see at least Rosen, col.10, lines 10-47) and WWW page 190 and image manipulation applet correspond to the second module).

4.2. Claims 7-8 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen and further in view of the web pages "americangreetings.com" as available to the public on Internet on November 15, 1999, extracted from [http:// www.archive.org](http://www.archive.org) on 8/22/03 ; hereinafter, referred to as Americangreetings.

Regarding claim 7, Rosen/Lahey teaches a method for facilitating the creation of personalized products as analyzed and disclosed in claim 1, above. Rosen/Lahey further discloses receiving a search query from the user via said communication network (see at least Rosen col.11, lines 23-42. Input by the user by selecting an item on the menu to order merchandize or selecting a graphic image on the menu for display corresponds to the search query from the user to the web server). Rosen/Lahey also teaches providing text message to the user via said communication network which can be used by the user to further enhance it or manipulate it as per his personal choice (see at least Rosen FIG.8B, " This is where you can add a paragraph of text.....Be creative, go wild, or go with what we have below").

Rosen/Lahey does not show presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein said assortment satisfies said search query.

However, Americangreetings in the same field of endeavor of customizing greeting cards on line, discloses presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein

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said assortment satisfies said search query (see the box " Our Greetings" and "Find More Greetings ". The box "Our Greetings" is a drop down box which presents an assorted list of greetings in alphabetical order starting from Anniversary, Baby, Birthday.....Thanks, Wedding and so on. Americangreetings presents a wide assortment of greetings text to the users in response to their requirements, such as befitting a birthday, anniversary or for a gift, etc. and it would be inherent that these greetings are retrieved from a database.)

In view of Americangreetings", it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen/Lahey to include the feature presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein said assortment satisfies said search query because this would enable the users/buyers to select and customize their greetings that they would like to post on their selected products for giving them as birthday or anniversary gifts.

Regarding claim 8, Rosen/Lahey/Americangreetings teaches receiving from said user via said communication network a selected text message from said assortment of text message selections; and incorporating said selected text message into said set of individualized enhancements using said design tool (see at least Rosen, col.5, lines 18-22 , "...that allow consumer 30 to identify the merchandize they wish to order, to customize the merchandize by providing a graphic image and a text message....", col.5, lines 41-43, "...WWW server 34 comprises bottles having labels customized with a graphic image and text message provided by consumer 30", col.9, lines 58-64, "....Additionally, the consumer may also be prompted to provide a text message 186 for inclusion on the customized merchandise).

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Regarding claims 18-19, all limitations are covered by the limitations of method claims 7 and 8 and are therefore analyzed and rejected based on the same rationale.

4.3. Claims 10 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen/Lahey and further in view of Gillespie et al. (US 2002/0059243 A1, hereinafter, referred to as Gillespie.).

Regarding claim 10, Rosen/Lahey teaches a method for facilitating the creation of personalized products as analyzed and disclosed in claim 1, above. Rosen/Lahey further teaches that once all the information about the customized product including information on graphic images and text messages provided by the consumer has been received by the WWW server 34 the graphic images are provided to print server 40 for printing the labels (see at least Rosen FIG.5, col.5, lines 36-54. Note: Print server 40 corresponds to a vendor in the application) in the EPS, JPG, GIF, and TIF file format (see Rosen FIG.8A, see box titled, " Pick Your Photo").

Rosen/Lahey does not teach converting said set of product configuration options and said set of individualized enhancements into at least one file having a format compatible with the needs of a vendor of said selected product.

Gillespie, in the field of same endeavor, teaches converting said set of product configuration options and said set of individualized enhancements into at least one file having a format compatible with the needs of a vendor of said selected product (see at least Page 1, paragraph 004, "...Converting the non-standard image file to a standard graphics image file format....").

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In view of Gillespie, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen/Lahey to include the feature of converting said set of product configuration options and said set of individualized enhancements into at least one file having a format compatible with the needs of a vendor of said selected product. Doing so would allow to accept graphic images from the users in the non-standard format and convert them into valid file types EPS, JPG, GIF, and TIF as required by the printer vendor/server and not letting the users worry about converting their non-standard file formats to EPS, JPG, GIF, and TIF standard formats.

Regarding claim 21, all its limitations are covered by the limitations of method claim 10 and is therefore analyzed and rejected based on the same rationale.

4.4. Claim 14 is rejected under 35 U.S.C. 103(a) as being obvious over Rosen/Lahey and further in view of Official Notice.

Regarding claim 14, Rosen/Lahey teaches a method for facilitating the creation of personalized products as analyzed and disclosed in claim 11, above. Rosen/Lahey further discloses incorporating a customized text message (see Rosen, col.5, lines 19-27, "...allow consumer 30 to identify the merchandize they wish to order; to customize the merchandize by providing a graphic image and a text message " and lines 39-43, "having labels customized with a graphic image and a text message provided by consumer 30 ". Note: Allowing consumer to customize the text message would inherently allow customer to position the text as per his choice). Rosen/Lahey also teaches image manipulation features such as

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image rotation, skewing, coloring which are known to those skilled in the art (see Rosen, col.10, lines 37-42).

Rosen/Lahey does not show explicitly that the user in customization of the merchandise also determines a font, color, size, and orientation of the text message.

Official Notice is taken of both the old and well-known concept and benefits of the features allowing computer users using Microsoft Word to determine the selection of the font, color, size and orientation as per his personal choice. Users can manipulate the size of the fonts to increase to appear big or small, can select a font out of the big list available to them, may use different colors to highlight messages like in red, blue or yellow and orient/rotate the text to customize as per his individual liking or choice while preparing social content expression cards like birthday and anniversary cards or preparing project reports to be read by others.

In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen/Lahey to include the feature of letting user determine a font, text color, text size, and text orientation because it would enable the customers to personalize the text message and customize the selected product as explained above.

4.5. Claims 25, 31, 42-43 and 52-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosen/Lahey and further in view of Americangreetings.

Regarding claim 25, Rosen/Lahey teaches a method for facilitating the creation of personalized products as analyzed and disclosed in claim 22, above. Rosen/Lahey further discloses receiving a search query from the user (see at least Rosen, col.11, lines 23-42. Input by the user by selecting an item on the menu to order merchandize or selecting a graphic image

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on the menu for display corresponds to the search query from the user to the web server).

Rosen/Lahey also teaches providing text message to the user via said communication network which can be used by the user to further enhance it or manipulate it as per his personal choice (see at least Rosen, FIG.8B, " This is where you can add a paragraph of text.....Be creative, go wild, or go with what we have below").

Rosen/Lahey does not show presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein said assortment satisfies said search query.

However, Americangreetings in the same field of endeavor of customizing greeting cards on line, discloses presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface; wherein said assortment satisfies said search query (see the box " Our Greetings" and "Find More Greetings ". The box "Our Greetings" is a drop down box which presents an assorted list of greetings in alphabetical order starting from Anniversary, Baby, Birthday.....Thanks, Wedding and so on. Americangreetings presents a wide assortment of greetings text to the users in response to their requirements, such as befitting a birthday, anniversary or for a gift, etc. and it would be inherent that these greetings are retrieved from a database.)

In view of Americangreetings", it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen/Lahey to include the feature of presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein said assortment satisfies said search query because this would enable the users/buyers to customize their greetings that they would like to post on their selected products for giving them as birthday or anniversary gifts, as explicitly disclosed in Americangreetings.

Regarding claim 31, Rosen/Lahey teaches all the limitations of claim 27 as analyzed above. The limitations recited in claim 31 are covered in claim 25 and are analyzed and rejected as obvious over Rosen/Lahey and further in view of Americangreetings on the basis of same rationale.

Regarding claims 42 and 43, Rosen/Lahey teaches a system to allow to design personalized products as disclosed and analyzed in claim 37 above. Rosen/Lahey further discloses a client computer 32 utilizing a WWW browser application program which enables the users to view, browse, search at WWW sites provided by WWW server 34, all databases, like product database 98, image database 100, customer database 96, etc. connected with the WWW server and to retrieve application programs from the WWW server for execution in the client computer (see Rosen, col.4, line 59-col.5, line 63). The client computer 32 utilizing a WWW browser application program is also capable to browse and search a message database if it is available at the Web site.

Rosen/Lahey does not show a message database in communication with said set of design tools, said message database comprising an assortment of text message selections and presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein said assortment satisfies said search query.

However, Americangreetings in the same field of endeavor of customizing greeting cards on line, discloses a message database in communication with said set of design tools, said message database comprising an assortment of text message selections and presenting to the user an assortment of text message selections retrieved from at least one text message

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database in communication with said design interface, wherein said assortment satisfies said search query (see the box " Our Greetings" and "Find More Greetings ". The box "Our Greetings" is a drop down box which presents an assorted list of greetings in alphabetical order starting from Anniversary, Baby, Birthday.....Thanks, Wedding and so on. Americangreetings presents a wide assortment of greetings text to the users in response to their requirements, such as befitting a birthday, anniversary or for a gift, etc. and it would be inherent that these greetings are retrieved from a database.)

In view of Americangreetings", it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen/Lahey to include a message database in communication with said set of design tools, said message database comprising an assortment of text message selections and presenting to the user an assortment of text message selections retrieved from at least one text message database in communication with said design interface, wherein said assortment satisfies said search query. Doing so would enable the users/buyers to customize their greetings that they would like to post on their selected products for giving them as birthday or anniversary gifts, as explicitly disclosed in Americangreetings.

Regarding claims 52-53, Rosen/Lahey teaches all the limitations of claim 46 as analyzed above. The limitations recited in claims 52-53 are covered by the claims 42-43 and are analyzed and rejected as obvious over Rosen/Lahey and further in view of Americangreetings on the basis of same rationale.

4.6. Claim 44 is rejected under 35 U.S.C. 103(a) as being obvious over Rosen/Lahey and further in view of Official Notice.

Regarding claim 44, Rosen/Lahey teaches a system to allow a user to design personalized products as disclosed and analyzed in claim 37 above. Rosen further discloses :

a personal database in communication with said set of design tools, said personal database being accessible only by a particular customer;

an upload tool in communication with said personal database, said upload tool configured so as to allow the particular user to upload design information from said personal database into said design buffer

(see at least Rosen, Fig.8 A, “. To upload your photo or artwork, click on the browser button and find the graphic file on your personal computer “, and col.9, lines 37-55). Note: The files stored in the personal computer corresponds to storing the photo or artwork files in a personal database which could only be accessed by the particular customer and those files can be accessed by the browser which interacts with the WWW server 34 and applet for manipulation of images as analyzed in claims 38-41 above);

a save tool (already covered in claim 37 above where a save tool saves and stores design information generated via design tools as default parameters to be invoked later).

Rosen does not show that said save tool is configured to allow the particular user to save design information from said design buffer into said personal database.

Official Notice is taken of the old and well known concept and benefits of saving information into said personal database for to retrieve later and use them again. In view of the Official Notice, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Rosen/Lahey as applied to claim 37 to incorporate the feature of saving design information from said design buffer into said personal database because it would allow the users to retrieve the saved information later to order additional quantity with the same

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features or to modify some parameters in the default features for ordering subsequent products without having to go through the process of custom designing and enhancing the product from the very beginning.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

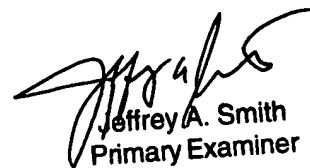
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yogesh C Garg
Examiner
Art Unit 3625

YCG
April 5, 2004.



Jeffrey A. Smith
Primary Examiner